UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,484	12/12/2003	William Ho Chang	1282-021/MMM	9610

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ART UNIT	PAPER NUMBER
2154	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/734,484	CHANG, WILLIAM HO
	Examiner	Art Unit	
	Joshua Joo	2154	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 December 2003*.

2a) ☐ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claim(s) *1-38* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Detailed Action

1.   Claims 1-38 are presented for examination.

2.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Group 1 (claims 1-23) discloses an invention for communicating data by <u>installing software application on a first computing device and wirelessly transmitting data from a second computing device</u>, classified in class 709, subclass 250.

II.   Group 2 (claims 24-29) discloses an invention for communicating data by <u>installing software on a first computing device and delivering and outputting data between a device and the first computing device</u>, classified, in class 717, subclass 176.

III.   Group 3 (claims 30-31) discloses an invention for communicating data by <u>discovering and selecting a communication device connected to a computing device from plural computing devices</u>, classified in class 709, subclass 213.

IV.   Group 4 (claim 32) discloses an invention for communicating data by <u>copying data from a first computing device to a communication device, and from a second computing device, selecting data for transmission from the communication device to the second computing device</u>, classified in class 709, subclass 249.

V.   Group 5 (claims 33 and 38) discloses an invention for communicating data by <u>discovering a second computing device through a first computing device and transferring content from the first computing device to the second computing device</u>, classified in class 709, subclass 249.

VI.   Group 6 (claim 34-37) discloses an invention for communicating data by <u>synchronizing data between a first and second computing device via communication device</u>, classified in class 709, subclass 248.

3.   Inventions I-VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, Invention I discloses of installing on a first computer, software application from a communication device for providing access to a data output service; wirelessly transmitting data

from a second computing device to the communication device; and passing the data from the communication device to the first computing computer, which are not found in groups II-VI.

Invention II discloses installing software over a network from a first device to a second device and delivering data content to an output service of a computing device to obtain output of the data content, which are not found in groups I, III-VI. The subcombination has s separate utility such as implementing the medium in a system to install software to allow two devices to communicate data.

Invention III discloses discovering a computing device from among plural computing devices by means of a wireless communication from a mobile device, each computing device having connected to it a communication device; selecting a selected communication device for a wireless data transfer by means of a selection of the mobile device; storing data transfer from a wireless communication device on a communication device, which are not found in groups I-II, IV-VI. The subcombination has a separate utility such as implementing the method in a system to choose a device among a plurality of devices for transferring and/or backing up data.

Invention IV discloses copying data from a first computing device to a communication device, and from a second computing device, discovering and selecting the communication device; and selecting data for wireless retrieval to the second computing device, which are not found in groups I-III, V-VI. The subcombination has a separate utility such as implementing the method in a system to transfer data from a first computing device to a wireless computing device.

Invention V discloses discovering through a first computing device a second computing device; selecting an output device associated with the second computing device for putting digital content; and wirelessly transmitting content from the first computing device to the second computing device, which are not found in groups I-IV, and VI. The subcombination has a separate utility such as implementing the method in a system to identify second device to transfer content from a first device.

Invention VI discloses launching software for retrieving data from a communication device,

storing the data to a storage device component of a second computing device, and removing the data from

the memory of the communication device, enabling the communication device to further receive and store

digital data, which are not found in groups I-V. The subcombination has a separate utility such as

implementing the method in a system to backup data from a wireless device to an external storage device.

4.   Because these inventions are distinct for the reasons given above, restriction for examination

purposes as indicated is proper. See also MPEP § 806.05(c).

5.   An election must be made by the applicant in replying to this Office Action.

Conclusion

6.   A shortened statutory period for reply to this Office action is set to expire ONE

MONTHS from the mailing date of this action.

7.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Joshua Joo whose telephone number is 571 272-3966 and fax number is 571 273-3966.

The examiner can normally be reached on Monday to Thursday 8 to 5:30.

8.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Nathan J. Flynn can be reached on 571 272-1915.

9.   Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained

from either Private PAIR or Public PAIR. Status information for unpublished applications is available

through Private PAIR only. For more information about the PAIR system, see http://pair-

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

December 17, 2007
JJ

NATHAN FLYNN
SUPERVISORY PATENT EXAMINER